

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

**Ex parte** SCOTT SEMENIK,  
FRANK ANNERINO,  
and MARTIN KIMBELL

---

Appeal No. 1997-3090  
Application 08/309,280

---

ON BRIEF

---

Before FLEMING, JERRY SMITH, and RUGGIERO, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 5 through 13. Claims 1 through 4 have been allowed. Claim 14 has been canceled.

The invention relates to vibrators and, more particularly, to brackets for mounting vibrators. Appellants

disclose on page 3 of the specification, the vibrator assembly 116 which includes a bracket 224 and a vibrator 226 as shown in Fig. 2. Appellants further disclose on page 4 of the specification that bracket 224 includes motor engagement members 260 and 261. On page 5 of the specification, Appellants disclose that Fig. 3 shows the motor engagement members 260 and 261 illustrated on how they would engage motor 228 as the motor is downwardly pressed in direction A. Appellants disclose that the fully assembled position is illustrated in Figs. 4 and 6. We note that Appellants' disclosure only shows embodiments which show first and second members 260 and 261 extending from the plate to hold the motor.

Independent claim 5 is reproduced as follows:

5. In combination:

a vibrator including a motor, a shaft driven by the motor and a weight carried on the shaft; and

a bracket including

a plate,

at least one member extending from the plate to hold the motor,

Appeal No. 1997-3090  
Application 08/309,280

and a shaft support extending from the plate and including an opening for receiving an end of the shaft remote from the motor, a diameter of the shaft being smaller than the opening to provide a gap between the shaft and the shaft support, wherein the shaft is positioned in the opening to permit rotation and

Appeal No. 1997-3090  
Application 08/309,280

some flexing of the shaft without a surface of the shaft contacting another surface and to limit deflection of the shaft to the gap within the opening to protect against severe deflection of the shaft.

The Examiner relies on no prior art in the rejection of the claims under appeal.

Claims 5 through 13 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Appellants regard as their invention.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief and answer for the respective details thereof.

#### ***OPINION***

After a careful consideration, we will not sustain the rejection of claims 5 through 13 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellants regard as their invention.

Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and

circumscribe the particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. ***In re Johnson***, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977), ***citing In re Moore***, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (1971). Furthermore, our reviewing court points out that a claim which is of such breadth that it reads on subject matter disclosed in the prior art is rejected under 35 U.S.C. § 102 rather than under 35 U.S.C. § 112, second paragraph. ***See In re Hyatt***, 708 F.2d 712, 715, 218 USPQ 195, 197 (Fed. Cir. 1983) ***citing In re Borkowski***, 422 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970). "The legal standard for definiteness is whether a claim reasonably appraises those of skill in the art of its scope." ***In re Warmerdam***, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

On page 3 of the answer, the Examiner notes that independent claims 5 and 9 each recite "at least one member extending from the plate." The Examiner argues that there is

Appeal No. 1997-3090  
Application 08/309,280

no disclosed embodiment in which there may only be one member  
extending from the plate to hold the motor. The Examiner  
correctly points out

that the Appellants disclose embodiments in which there are two members extending from the plate to hold the motor.

On page 3 of the brief, Appellants argue that the claims do not set forth an ambiguity. Appellants argue that the claims define one or more members for holding the motor and meet the requirement of 35 U.S.C. § 112, second paragraph.

Upon our review of the recited language, "at least one member extending from the plate," we find that the scope of the claim is clear. The language sets out and circumscribes a particular area with a reasonable degree of precision and particularity. We find that the scope of the claim language would only require one member extending from the plate to hold the motor. Therefore, we find that the claim language meets the requirements of 35 U.S.C. § 112, second paragraph.

We have not sustained the rejection of claims 5 through 13 under 35 U.S.C. § 112, second paragraph. Accordingly, the Examiner's decision is reversed.

**REMAND TO THE EXAMINER**

We remand this application to the Examiner for consideration of the following matters. On page 3 of the

Appeal No. 1997-3090  
Application 08/309,280

answer, the Examiner states that Appellants' disclosure does not set forth an embodiment in which there can be only one member extending from the plate to hold the motor. The Examiner points out that in each of the embodiments there are two members extending from the plate to hold the motor. The Examiner needs to properly consider whether Appellants had possession, as of the filing date of the application, of the specific subject matter later claimed by Appellants.

The Examiner shall determine under the following legal analysis whether the claims should be rejected under 35 U.S.C. § 112, first paragraph, for failing to meet the description requirement of that paragraph.

"The function of the description requirement [of the first paragraph of 35 U.S.C. 112] is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." ***In re Wertheim***, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "It is not necessary that the application describe the claim limitations exactly, . . . but only so clearly that persons of ordinary skill in the art will



Appeal No. 1997-3090  
Application 08/309,280

recognize from the disclosure that appellants

Appeal No. 1997-3090  
Application 08/309,280

invented the processes including those limitations."

**Wertheim**, 541 F.2d at 262, 191 USPQ at 96 **citing In re Smythe**, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973).

Furthermore, the Federal Circuit points out that "[i]t is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed." **In re Wilder**, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), **cert. denied**, 469 U.S. 1209 (1985), **citing In re Kaslow**, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). "To fulfill the written description requirement, the patent specification 'must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."

**Centry Gallery Inc. v. Berkline Corp.**, 134 F.3d 1473, 1479, 45 USPQ 1498, 1503 (Fed. Cir. 1998) **citing In re Gosteli**, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). "An applicant is entitled to claims as broad as the prior art and **his disclosure** will allow." **In re Rasmussen**, 650 F.2d

Appeal No. 1997-3090  
Application 08/309,280

1212, 1214, 211 USPQ 323, 326 (CCPA 1981). (Emphasis added).

Appeal No. 1997-3090  
Application 08/309,280

This application, by virtue of its "special" status,  
requires an immediate action. MPEP § 708.01(d). It is  
important that the Board be informed promptly of any action  
affecting the appeal in this case.

**REVERSED AND REMANDED**

JERRY SMITH	)	
Administrative Patent Judge)	)	
	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS AND
Administrative Patent Judge)	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge)	)	

Appeal No. 1997-3090  
Application 08/309,280

JONATHAN P. MEYER  
MOTOROLA, INC.  
INTELLECTUAL PROPERTY DEPT.  
600 NORTH U.S. HWY. 45  
LIBERTYVILLE, ILLINOIS 60048

MRF/dal

Appeal No. 1997-3090  
Application 08/309,280